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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/834,025  | 04/12/2001  | Yoshiyasu Kubota     | SONYJP 3.0-154      | 5235             |
| 7590  | 10/08/2003  |                      | EXAMINER            |                  |
| LERNER, DAVID, LITTENBERG<br>KRUMHOLZ & MENTLIK, LLP<br>600 SOUTH AVENUE WEST<br>WESTFIELD, NJ 07090-1797 |             |                      | SCHNEIDER, JOSHUA D |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2182                | 8                |
| DATE MAILED: 10/08/2003   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/834,025             | KUBOTA, YOSHIYASU   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Joshua D Schneider     | 2182                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 August 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed 8/6/2003 have been fully considered but they are not persuasive. With regards to claims 1-10, the Applicant has argued the rejection under 35 U.S.C. 103(a) over U.S. Patent 5,901,303 to Chew is improper because the reference teaches away from the claims. However, Chew does not wish to keep data and information about the function from being exchanged between the card and the main unit, as the Applicant believes (Amendment A, page 12). Instead, Chew teaches the card is communication with the terminal, and receives signals from the terminal (column 4, lines 19-25) to select data elements and functions. The security risk of the prior art is eliminated by having the function performed entirely on the card. So while the function is *performed* in a transparent manner, it is not transparent to the terminal insomuch that the terminal does not have knowledge of the function, as the Applicant suggests.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,901,303 to Chew. With regards to claims 1, 6, 11, and 16, Chew teaches providing a removably connected electronic device (in this case a smart card), having a register (memory), having a write area and a read area (Fig. 1, and column 4, lines 53-64). The card performs startup processes and then receives a command from the main unit (reader, column 6, lines 14-

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21). Chew does not explicitly distinguish a read and a write area of a register. However, it would have been obvious to one of ordinary skill in the art at the time of invention that the RAM memory acts as a writing area when the card receives commands for processing, and that the reading area could be embodied in either data buffered in the RAM or data in either ROM or programmable memory as was well known in the art. It is inherent to Chew that the requested function is written into the write area of the register (RAM) when the command is processed (column 6, lines 19-21). Chew then teaches the reading of a code of a function (column 6, lines 19-21 and 26-27, and column 4, line 63, though column 5, line 5), and a code associated therewith (column 5, lines 5-12). Chew also teaches detection of a requested function by the main reader unit (column 4, lines 19-25).

4. With regards to claims 2, 7, 12, and 17, Chew teaches a list of codes of the functions (column 6, lines 19-21), and a code associated therewith (column 5, lines 5-12). Chew does not explicitly teach the list being at a predetermined address. It would have been obvious to one of ordinary skill in the art at the time of invention that the list of codes of the functions would have to have been at a predetermined address for it to be accessed by the operating system (column 6, lines 19-21).

5. With regards to claims 3, 8, and 13, Chew teaches the determination of a function to be executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27).

6. With regards to claims 4, 9, and 14, Chew teaches the determination of a function to be executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27). Chew teaches a list of codes of the functions (column 6, lines 19-21), and a code associated therewith (column 5, lines 5-12). Chew does not explicitly teach the list being at a

predetermined address. It would have been obvious to one of ordinary skill in the art at the time of invention that the list of codes of the functions would have to have been at a predetermined address for it to be accessed by the operating system (column 6, lines 19-21).

7. With regards to claims 5, 10, and 15, Chew teaches the enablement of the execution of a function after the determination (column 6, lines 26-27).

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,901,303 to Chew as applied to claims 1-17 above, and further in view of U.S. Patent 6,574,677 to Song et al. Chew fails to teach the activation of a driver and the driver enabling the function to be executed. Song teaches the use of a driver for the configuration of the communication method to enable the use of a smart card (column 2, lines 18-25). The use of drivers to establish communication with storage media in media reading devices is common in the art. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the function determination of Chew with the driver enablement of Song to create a reader that can properly interface with media cards in a safe, secure, and reliable manner.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,606,161 to Murata teaches the use of a driver when reading memory cards.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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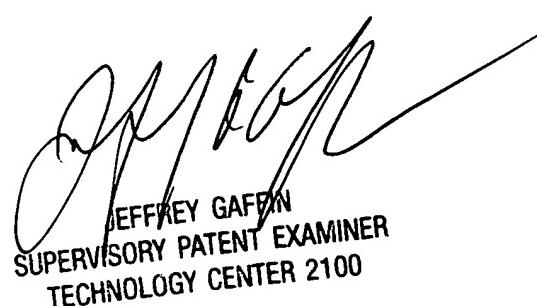
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JDS



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100